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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,367	03/29/2000	Takashi Sawano	49659(904)	6664
21874	7590	02/19/2004	EXAMINER PARK, CHAN S	
EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205			ART UNIT 2622	
			PAPER NUMBER	

DATE MAILED: 02/19/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/537,367

Applicant(s)

SAWANO, TAKASHI

Examiner

CHAN S PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-39 is/are allowed.
- 6) ☒ Claim(s) 1,8,11,18, and 19 is/are rejected.
- 7) ☒ Claim(s) 2-7,9,10,12-17 and 20-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because "state 5" of fig. 5 does not correspond with the specification. According to the specification describing state 5 in page 25, K+1th page replaces **page 1 only and not Kth page**. However, the drawing is unclear when both page 1 and page K are not shown in state 5.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8, 11, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. With respect to claims 1 and 19, it is not clearly understood if a "page unit" holds a plurality of pages of the print data or one page of the print data. It is conventionally known that a page unit only holds one single page of print data.

It is not clearly understood if the second print data is saved in the memory means prior printing or the data is bypassing the memory means.

It is not clearly understood if the first print data and the second print data are combined within the memory. According to fig. 4 of the specification, the second data is

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not combined with the first data within the memory since the memory is full. It is not clearly understood where the data are being combined.

3. With respect to claims 8 and 11, the memory means is initially understood as a memory since claim 1 recites "a memory capacity of the memory means." It is not clearly understood when claims 8 and 11 recite that the memory means "divides" a storage area.

4. With respect to claim 18, the claim recites the limitation "were re-transmitted" in line 18. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibaki et al. U.S. Patent No. 6,052,201 in view of Ueda U.S. Patent No. 5,964,851.

5. With respect to claim 1, the Shibaki et al. reference discloses a printing system (image forming apparatus in col. 3, line 34) including a scanner which reads print data in page unit (col. 4, lines 20-49 & col. 6, line 65) and a printing device (image forming section 160) which prints out the print data transmitted from the scanner (col. 4, line 56 – col. 5, line 2),

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Said printing device further including memory means (PM 323 in fig. 2) for storing pages of the print data at least partially (col. 7, lines 59-63),

Wherein, when the print data are to exceed a memory capacity of the memory means, the print data are printed out by combining first print data, which correspond to print data within the memory capacity of the memory means (portions of original image in col. 8, lines 17-18), and second print data, which correspond to print data exceeding the memory capacity of the memory means (images of the remaining originals in col. 8, lines 23-24) and which are read and transmitted from the scanner.

Since the claim fails to specify as to where and at what step the print data are combined, Examiner interpreted that the print data are combined when they are all printed out from the printing device.

Shibaki et al. does not disclose expressly that the print data is transmitted from a host device.

Ueda discloses a printer that receives a created print data in a page unit from a host computer (col. 4, lines 6-11).

Shibaki et al. and Ueda are analogous art because they are from the same field of endeavor, which is the printing art.

Since Shibaki et al. teaches that the image forming apparatus can be used as a printer (col. 3, line 37) and transmitting a plurality of pages of print data to the digital copier is well known in the art at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the page memory controlling system in the printer of Shibaki et al. with the printer that received print data from a host of Ueda.

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The suggestion for doing so would have been to print data that are created by external devices like host computer.

Therefore, it would have been obvious to combine Shibaki et al. with Ueda to obtain the invention as specified in claim 1.

6. With respect to claim 19, arguments analogous to those presented for claim 1, are applicable.

***Allowable Subject Matter***

7. Claims 2-7, 9, 10, 12-17, and 20-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 8 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Claim 18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

10. Claims 34-39 are allowed.

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**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

Chan S. Park  
January 26, 2004

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
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